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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,543	02/27/2004	Stephen V. Deckers	10004377-4	7095

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EXAMINER	
TRAN, KHOI H	

ART UNIT	PAPER NUMBER
3651	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/788,543	DECKERS, STEPHEN V.	
	Examiner	Art Unit	
	Khoi H Tran	3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 21-32 is/are pending in the application.

4a) Of the above claim(s) 22,23,25,29,30 and 32 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 21,24,26-28 and 31 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

KHOI H. TRAN
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 05/02/05.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 21, 24, 26-28, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski et al. 6,731,455 in view of Stefansky 5,329,412.

Kulakowski '455 discloses a data storage library per claimed invention. The library comprises a plurality of storage areas for housing plurality of hard disk drive devices (HDD, see Figures 1A and 4). Each of the hard disk drive devices comprises a power supply (Figure 1A). The library comprises robotic grippers 62 for gripping and moving said HDD 's (Figures 2 and 3) from/to said storage areas. The library comprises a host device 72 (Figure 2) for controlling the library operations. The library comprises plurality of interfaces for communicatively linking or docking the HDD 's to the host device (Figures 2, 3, and 4). Kulakowski '455 data storage library is also capable of handling tape cartridges or a combination of tape and hard disk drive devices (column 11, lines 21-47). However, Kulakowski '455 is silent as to the specific of the HDD having form factor in the shape of a tape cartridge.

Stefansky '412 discloses a portable hard disk drive device. Stefansky '412 teaches that the hard disk drive device housing can have the dimension of a tape cartridge (column 1, lines 55-61).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have the housing dimension of Kulakowski '455 HDD coincides with the housing dimension of a magnetic tape cartridge, as taught by Stefansky '412, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F .2d 272, 205 USPQ 215 (CCPA 1980). Furthermore, it would have been obvious for one of ordinary skill in the art to have provided Kulakowski '455 HDD with a housing having the same dimension of a magnetic tape housing because such HDD cover had been known in the art, as demonstrated by Stefansky '412.

In regards to claims 24 and 31, Kulakowski '455 discloses all elements per claimed invention as explained above. However it is silent as to the specifics of the HDD having form factor in the shape of a Digital Linear Tape (DLT).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have the housing dimension of Kulakowski '455 HDD coincides with the housing dimension of a Digital Linear tape cartridge since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F .2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

3. It is noted that Applicant's intention is not to claim the "docking device" as part of the claimed combination. Therefore, the claimed phrase "adapted to...docking device" would not be given any patentable weight.

4. Applicant's arguments filed 05/02/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Stefansky '412 shows that portable hard disk drive device can be housed in a cover that has the dimensions and form factor (rectangular) of a tape cartridge. Thus, it would have been obvious for one of ordinary skill in the art to have provided Kulakowski '455 HDD with a housing having the same dimensions of a magnetic tape housing because such HDD cover had been known in the art. In addition, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art, In re Boesch, 617 F .2d 272, 205 USPQ 215 (CCPA 1980), it would have been obvious to one having ordinary skill in the art at the time of the invention was made to have the rectangular housing dimensions of Kulakowski

'455 HDD coincide with the rectangular housing dimensions of a magnetic tape cartridge, as taught by Stefansky '412.

Applicant's argued that there is no reasonable expectation of success in combining the references of Kulakowski and Stefansky because the hard disk cartridges of the two references are different. Applicant argued that the "dual-ended" cartridge of Kulakowski could not be physically modified to be a "single-ended" cartridge, as taught by Stefansky '412. Applicant argued that in order to use the teaching in the secondary reference, one would have to bodily combine the "single-ended" data interface of the secondary reference into the primary reference. Essentially, these arguments are based on the feasibility of bodily incorporate the features in the secondary reference into the primary reference. These arguments are not persuasive. Applicant's attention is directed to the understanding that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, it is the combined teachings of providing a hard disk drive and a housing having the dimensions of a tape cartridge for a hard disk drive that provide the motivation to combine the secondary reference with the primary reference. Furthermore, please note that as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require

that the references be combined for the reasons contemplated by the inventor. See In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc), Cert. Deneid, 500 US 904 (1991) and In re Beattie, 974 F. 2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

Applicant argued that Stefansky 's housing does not have a tape cartridge form factor, and thus, Stefansky does not have the teaching of providing a housing having a tape cartridge form factor. Nevertheless, Applicant concurred that Stefansky discloses "a single disk drive which...conforms to the dimension of a tape..." (Applicant's remarks filed on 12/30/2004). Since the disk drive at least conforms to the dimension of a tape, it has a tape cartridge form factor. Applicant argued that the prior arts do not have "a tape cartridge form factor" per the specification. Unfortunately, Applicant's specification is also silent as to the exact size and shape of a "tape cartridge form factor". Lacking specific size and dimension, any rectangular cartridge is considered to be a tape cartridge form factor.

Applicant argued that Kulakowski does not disclose or suggest the use of tape cartridges in a library system. This argument is irrelevant to the rejections because Applicant does not claim the handling of any tape cartridges. Applicant only claims a hard disk drive having a housing in the form of a tape cartridge.

Conclusion

5. This is an RCE of applicant's earlier Application No. 10/788,543. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next

Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H Tran whose telephone number is (571) 272-6919. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Matecki can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Khoi H Tran
Primary Examiner
Art Unit 3651

KHT
05/13/2005